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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/024,496  
Filing Date: December 21, 2001  
Appellant(s): RUBINSTENN ET AL.

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Kenie Ho  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed 2/03/2006 appealing from the Office action mailed 8/03/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Maloney et al.	WO 01/18674 A2	15 March 2001
Fox et al.	US 5,796,932	18 August 1998
Anderson	US 2002/0082869 A1	27 June 2002
Farchione	US 2002/0059248 A1	16 May 2002
Ogilvie et al.	Why Women Wear Lipstick: Preliminary Findings. Internet printout.	

**(9) Grounds of Rejection**

Claim Rejections under 35 USC § 112 and 35 USC § 101 have been withdrawn.

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11, 13-16, 18-25, 32-39, 41, 43, 44, 46-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-11, 13-16, 18-25, 32-39, 41, 43, 44, 46-50 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the

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apparatus which accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1-11, 13-16, 18-25, 32-39, 41, 43, 44, 46-50 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of 35 U.S.C. 102(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 25 and 26 are rejected under 35 U.S.C. 102(a) as being anticipated by Maloney et al. (WO 01/18674).**

Maloney et al. (Maloney) teaches a method for providing a customized product combination to a consumer, comprising:

**Claim 25.** Obtaining personal information about a consumer, the personal information including at least demographic information about the consumer, the demographic information reflecting a geographic area location of the subject (delivering a product to the customer indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); generating a list of a plurality of cosmetic products for the consumer (P. 7, L. 13-16); receiving from the subject a request for cosmetic advice (P. 2, L. 7-8); accessing local

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information (water hardness, pH level) for the geographic area (P. 10, L. 7-8; P. 11, L. 11-12); and generating at least one recommendation for use of at least one cosmetic product on the list, the at least one recommendation being a function of the personal information and the local information (P. 7, L. 15-16).

**Claim 26.** Said method, wherein receiving the request occurs via a network and in at least one location remote from a location of the consumer (P. 4, L. 7-10).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-9, 11-13, 17, 18, 20-24, 27, 30-32 and 34-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Fox et al. (US 5,796,932).**

Maloney teaches a computer-implemented method and system for providing a customized product combination to a consumer, said system comprising a processor and a memory for storing personal information about a

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customer and an executable code for conducting said method (P. 18, L. 1-34),  
said method comprising:

**Claims 1 and 27.** Obtaining personal information about a consumer, the personal information including at least demographic information about the consumer, the demographic information reflecting a geographic area location of the subject (delivering a product to the customer indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (environmental data) corresponding to the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least the personal information and the local information (P. 7, L. 14-15; P. 7, L. 11-13).

Maloney does not specifically teach that said determined local information, which corresponds to the demographic information, is determined based on said demographic information.

Fox et al. (Fox) teaches a computer-implemented method and system for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8). Furthermore, Fox teaches that so as weather is a local phenomenon, determining and predicting local weather

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conditions based on determined location information can predict the impact of weather on sales of goods in said determined location (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include determining and predicting local weather conditions based on local information, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather information (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

**Claim 2.** Fox teaches said method and system, wherein said local information includes weather forecast (C. 13, L. 3-8).

**Claim 3.** Obtaining information about recent purchases of cosmetic products from each consumer, and having address information of said each consumer indicates obtaining data on cosmetic usage of others located in the geographic area of the subject (Maloney; P. 12, L. 17-18).

**Claim 4.** Fox teaches said method and system, wherein said local information includes weather forecast including temperature, precipitation and snowfall (C. 6, L. 13-14), thereby indicating *air quality data*.

**Claims 5 and 11.** Fox teaches said method and system, wherein said local information includes historical and actual weather conditions and predicted weather forecast including temperature, precipitation and snowfall (C. 6, L. 13-14), thereby indicating *climate data for the geographic area*.



**Claims 6.** Obtaining local water hardness and pH level information indicates obtaining ecological data for the geographic area of the subject (Maloney; P. 10, L. 7-8; P. 11, L. 11-12).

**Claim 7.** Said method, wherein the personal information further includes lifestyle (Maloney; P. 7, L. 2).

**Claim 8.** Said method, wherein the lifestyle information includes at least one of fashion preferences, clothing color preferences, and cosmetic preferences (Maloney; P. 11, L. 27-30).

**Claim 9.** Said method, wherein the physical characteristics information includes at least one of age, a skin condition, skin tone, a propensity to tan, hair color, and facial feature characteristics (Maloney; P. 7, L. 1-3).

**Claim 12.** Receiving over a network, at a site remote from the subject, the personal information about the subject, and transmitting the recommendation to the consumer over the network (Maloney; P. 4, L. 7-10).

**Claim 13.** Generating recommendation based on physical characteristics information, the local information, and the variable preference information (Maloney; P. 4, L. 18-23).

**Claims 17-18.** Accessing the node *prior to* the time of intended cosmetic application (See claim 1). Information as to *immediately prior, or in an evening before, or in a day of intended cosmetic application* is non-functional language

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and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The step of "accessing the node prior to the time of intended cosmetic application" would be performed regardless the actual time of intended cosmetic application. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney in view of Fox to include that said "accessing the node *prior* to the time of intended cosmetic application" includes *immediately prior, or in an evening before, or in a day of intended cosmetic application*, or in any other day prior to the intended cosmetic application because it would advantageously allow the subject to do it based on her/his schedule and convenience.

**Claim 20.** Obtaining information about recent purchases of cosmetic products from a consumer indicates receiving an identification of products at the subject's disposal (P. 12, L. 17-18).

**Claim 21.** Said method, wherein the physical characteristics information includes at least one of color, tone, texture, elasticity, oiliness, and pH of at least one of the subject's hair and skin (Maloney; P. 11, L. 9-10).

**Claims 22-24.** Same reasoning as applied to claim 1.

**Claim 30.** Maloney teaches said system for providing beauty advice, the system comprising: a memory including a program that obtains personal information about a customer, the personal information including at least demographic information about the customer, the demographic information reflecting a geographic area location of the subject and geographic area location information of the consumer (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determines local information corresponding to the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generates and presents at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14-15); and a processor that runs the program (P. 14, L. 3-12).

Maloney does not specifically teach that said determined local information, which corresponds to the demographic information, is determined based on said demographic information.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based

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on determined location information can predict the impact of weather on sales of goods in said location (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include predicting local weather conditions based on local information functionality, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

**Claim 31.** Maloney teaches a computer-readable medium containing instructions for causing a computer to perform said computer-implemented method for providing beauty advice, the method comprising: obtaining personal information about a customer, the personal information including at least demographic information about the customer, the demographic information reflecting a geographic area location of the subject and geographic area location information of the consumer (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information corresponding to said local information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14, L. 3-15).

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Maloney does not specifically teach that said determined local information, which corresponds to the demographic information, is determined based on said demographic information.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods in said location (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include determining and predicting local weather conditions based on local information, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

**Claim 32.** Maloney teaches said method for providing a customized product combination to a consumer, comprising:

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maintaining a plurality of consumer categories (P. 6, L. 32 – P. 7, L. 11; P. 9, L. 33-35); obtaining information identifying a geographic area where beauty advice is to be dispensed (delivering a product to the customer indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); obtaining local information corresponding to the geographic area (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting a plurality of differing cosmetic product usage recommendation, each recommendation being a function of the local information and at least one of the plurality of categories (P. 7, L. 14-15; P. 7, L. 11-13).

Maloney does not specifically teach that said local information includes weather forecast for the geographic area.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting location information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said location information (C. 13, L. 3-8). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods in said local area (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include that said local

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information includes weather forecast for the geographic area, as disclosed in Fox, because it would advantageously allow to utilize forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

Furthermore, Maloney teaches:

**Claim 34.** Presenting includes organizing recommendations by category (P. 7, L. 5-13).

**Claim 35.** Obtaining information about recent purchases of cosmetic products from each consumer, and having address information of said each consumer indicates obtaining data on cosmetic usage of others located in the geographic area of the subject (P. 12, L. 17-18).

**Claim 36.** Said method, wherein the personal information further includes lifestyle (P. 7, L. 2).

**Claim 37.** Said method, wherein the physical characteristics information includes at least one of age, a skin condition, skin tone, a propensity to tan, hair color, and facial feature characteristics (P. 7, L. 1-3).

**Claim 38.** See reasoning applied to claim 32.

**Claim 39.** Generating recommendation based on physical characteristics information, the local information, and the variable preference information (P. 4, L. 18-23).

**Claim 40.** Said method conducted in a network environment (P. 16, L. 20-34).

**Claim 41.** Maloney teaches said method for providing a customized product combination to a consumer, comprising:

obtaining demographic information about the consumer (delivering a product to the customer indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information corresponding to said obtained demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product in the geographic area based on the information (P. 7, L. 14, L. 3-15).

Maloney does not specifically teach that said local information is determined by manipulating said received demographic information.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information by manipulating said demographic (location) information (C. 13, L. 3-8; C. 18, L. 56 – C. 19, L. 5). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts



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local weather conditions based on determined location information can predict the impact of weather on sales of goods in said local area (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include said determining local weather conditions by manipulating said local information, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

**Claim 42.** Said method conducted in a network environment (Maloney; P. 16, L. 20-34).

**Claim 43.** Maloney teaches said method for providing a customized product combination to a consumer, comprising:

obtaining personal information about a consumer, the personal information including at least demographic information about the consumer, the demographic information reflecting a geographic area location of the consumer (delivering a product to the customer indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information corresponding to the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating at least one cosmetic analysis based on at least one of the personal information and the local information and presenting the at least one cosmetic analysis (P. 7, L. 14-15).

Maloney does not specifically teach that said determined local information is determined based on said demographic information.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods in said local area (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include determining and predicting local weather conditions based on local information, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

**Claims 44, 46 and 47.** Same reasoning as applied to claim 43.

**Claim 45.** Conducting said method in a network environment (Maloney; P. 16, L. 20-34).

**Claim 48.** Fox teaches determining local information by manipulating the demographic information (C. 13, L. 3-8; C. 18, L. 56 – C. 19, L. 5).

**Claim 49.** Maloney teaches said method for providing a customized product combination to a consumer, comprising:

obtaining personal information about a consumer, the personal information including at least demographic information about the consumer, the demographic information reflecting a geographic area location of the consumer (delivering a product to the customer indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information corresponding to the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14-15; P. 7, L. 11-13).

Maloney does not specifically teach that said determined local information is determined based on said demographic information and historical information associated with said area.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), providing a historical weather information for various regions; accessing and determining local weather information based on said

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demographic (location) information and historical weather information for said geographical region (C. 13, L. 3-8).

Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods in the local area (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include determining local information based on said demographic information and historical information associated with said area, as disclosed in Fox, because it would advantageously allow to utilize local actual and historical weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

**Claim 50.** Fox teaches projecting local (weather) information based on the demographic (geographical) information and the historical (weather) information (C. 6, L. 12).

**Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. in view of Fox et al. and further in view of Anderson (US 2002/0082869).**

**Claim 10.** Maloney in view of Fox teaches all the limitations of claim 10, except that family history information includes historical physical characteristics information about relatives of the consumer.

Anderson teaches a method for providing and updating customized health care over the Internet, wherein personal data of an individual includes age and medical history of the individual's relatives [0016].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney in view of Fox to include that said family history information includes historical physical characteristics information about relatives of the consumer, as disclosed in Anderson, because it would advantageously allow to determine and exclude certain beauty product ingredients which may cause negative health conditions or even diseases to which the consumer may have a predisposition.

**Claims 14-16, 28, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. in view of Fox et al. and further in view of Farchione (US 2002/0059248).**

**Claim 14.** Maloney in view of Fox teaches said method, wherein the variable preference information includes an identification of clothing that the subject intends to wear (Maloney; P. 7, L. 16-19). Maloney and Fox does not

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specifically teach that said recommendation contains a suggestion to use at least one product complementary to the identified clothing.

Fachione teaches a method and system for determining proper color for makeup and clothing, including suggesting to use at least one cosmetic product complementary to the desired fashion outlook [0023]; [0010].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney in view of Fox to include suggesting to use at least one cosmetic product complementary to the desired fashion outlook, as disclosed in Fachione, because it would advantageously allow to provide customers with a product most suitable for customer's physical characteristics, as specifically taught in Fachione [0005].

**Claim 15.** Said method, wherein the identification of clothing is a color of clothing (Fachione; [0010]). The motivation to combine the references would be providing customers with a product most suitable for customer's physical characteristics.

**Claim 16.** Said method, wherein the product is a cosmetic product for adding color to a face of the subject (Fachione; [0003]). The motivation to combine the references would be providing customers with a product most suitable for customer's physical characteristics.

**Claim 28.** Fachione teaches generating a suggestion for clothing based on the obtained information [0027]. The motivation to combine the references would be providing customers with a product most suitable for customer's physical characteristics.

**Claim 29.** Facione teaches that said cosmetic product is chosen from makeup and hair product [0019]. The motivation to combine the references would be providing customers with a product most suitable for customer's physical characteristics.

**Claim 33.** Facione teaches presenting the recommendations to a beauty consultant [0003]. The motivation to combine the references would be presenting most suitable cosmetic products for those customers who prefer to interact with a beauty consultant.

**Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. in view of Fox et al. and further in view of Official Notice.**

**Claim 19.** Maloney in view of Fox teaches all the limitations of claim 19, except *suggesting* that the consumer maintain a stock of the plurality of cosmetic products.

Official notice is taken that it is well known that a plurality of consumers have a habit to use cosmetic product every day (See, for example, Ogilvie et al.: Why Women Wear Lipstick: Preliminary Findings; page 4, 5<sup>th</sup> paragraph).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney in view of Fox to include suggesting that the consumer maintain a stock of the plurality of cosmetic

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products, because it would advantageously allow the consumer never run out of cosmetic products especially when the consumer needs them the most.

#### **(10) Response to Argument**

*Arguments A and B*  
*(Brief, pages 16-23)*

Claim Rejections under 35 USC § 112 have been withdrawn.

In response to applicant's argument that Claim Rejections under 35 USC § 101 is improper, it is noted that claims 1-11, 13-16, 18-25, 32-39, 41, 43, 44, 46-50 while directed to a series of steps, identify neither the apparatus performing the recited steps, nor any transformation of underlying materials, and could be understood as merely mental activity. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). So as claims 1-11, 13-16, 18-25, 32-39, 41, 43, 44, 46-50 do not positively recite: the other statutory class to which it is tied (e.g., by identifying the apparatus which accomplishes the method steps), or the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state), claims 1-11, 13-16, 18-25, 32-39, 41, 43, 44, 46-50 are considered to be directed to non-statutory subject matter.



Argument C  
Claims 25 and 26 (Brief: pages 24-25)

In response to applicant's argument that Maloney fails to disclose "accessing local information for the geographic area", it is noted that Maloney does, in fact, teach this feature. Specifically, Maloney teaches:

"the collection of profiling data about a consumer comprises providing the consumer a test kit. ... Preferably, such a test kit would also comprise additional environmental tests (such as water hardness, water pH, etc.) which effects the performance of beauty care products. ... The test kit is delivered to the consumer and the consumer then provides the results and input from such test..." (P. 11, L. 6-14), and:

"Additional consumer profiling data is identified to customize the selected product to meet the consumer's physiological conditions and external conditions (such as water hardness, etc.)" (P. 10, L. 6-8).

Clearly, Maloney discloses "accessing local information (such as water hardness, water pH, etc.) for the geographic area (place of presence of the consumer to whom the test kit is delivered)".

In response to applicant's argument that Maloney fails to disclose "generating at least one recommendation for use of at least one cosmetic product on the list, the at least one recommendation being a function of the personal information of the subject and the local information," it is noted that Maloney teaches providing the consumer with customized beauty care products, including

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shampoo, conditioner, lotion, facial cleanser, etc. (P. 7, L. 16, 24-26). Examiner stipulates, that under broadest reasonable interpretation providing shampoo or lotion constitutes “generating recommendations” for use of said products.

*Argument D*

*Claims 1-9, 11-13, 17, 18, 20-24, 30, 31 and 48 (Brief: pages 25-28)*

In response to applicant's argument that Maloney and Fox fail to teach or suggest “generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information, which is determined based on demographic information”, Examiner points out that Maloney teaches: obtaining personal information about a consumer including a geographic area location of the subject (delivering a product to the customer indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (environmental data) *corresponding to* the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least the personal information and the local information (providing shampoo or lotion indicates “generating recommendations” for use of said products) (P. 7, L. 14-15; P. 7, L. 11-13, 16, 24-26).

Fox was applied to show determining local (weather) information based on demographic (geographical) information. Specifically, Fox teaches a computer-implemented method and system for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic

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(location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to providing personal care products or services to consumers based on demographic information. So as weather is a local phenomenon, determining and predicting local weather conditions based on determined location information can predict the impact of weather on sales of goods in said determined location (Fox; C. 4, L. 10-11, 58-61). As such, the motivation to combine references to include determining and predicting local weather conditions based on local information, as disclosed in Fox, would be utilizing local actual and forecasted weather information (e.g., temperature and humidity) in planning of sales and advertising of personal care products to maximize profits.

*Claim 27 (Brief, pages 28-30)*

In response to applicant's argument that Maloney and Fox fail to teach or suggest "memory for storing personal information about a subject", "memory for storing a program that accesses local information . . . and generates at least one recommendation for use of at least one cosmetic product, the at least one recommendation being a function of the personal information of the subject and the local information" and "a processor that runs the program," it is noted, that Maloney explicitly teaches this feature. Specifically, Maloney teaches a computer-readable storage medium containing computer executable code for instructing a computer to perform the following steps: collecting consumer profiling data about a consumer, said data including personal data and local data, and determining a customized beauty care product based on said personal data and local data (P. 18, L. 1-34).

As per applicant's argument that Maloney and Fox fail to teach or suggest "generating at least one recommendation for use of at least one cosmetic product, Maloney teaches providing customized beauty products, including shampoo or lotion (P. 7, L. 16, 24-26), which constitutes "generating recommendations" for use of said products.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce

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the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to providing personal care products or services to consumers based on demographic information. So as weather is a local phenomenon, determining and predicting local weather conditions based on determined location information can predict the impact of weather on sales of goods in said determined location (Fox; C. 4, L. 10-11, 58-61). As such, the motivation to combine references to include determining and predicting local weather conditions based on local information, as disclosed in Fox, would be utilizing local actual and forecasted weather information (e.g., temperature and humidity) in planning of sales and advertising of personal care products to maximize profits.

Claims 32-40 (Brief: pages 30-31)

In response to applicant's argument that Maloney does not disclose obtaining local information including a weather forecast, it is noted that Fox was applied for this feature. Specifically, Fox teaches a computer-implemented method and system for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8).

In response to applicant's argument that Fox does not disclose generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information that includes the weather forecast", it is noted that Maloney teaches providing customized beauty products, including shampoo or lotion (P. 7, L. 16, 24-26), which constitutes "generating recommendations" for use of said products. As per "weather forecast" feature per se, see reasoning above.

Claims 41 and 42 (Brief: pages 32-33)

In response to applicant's argument that Maloney and Fox fail to teach or suggest "generating at least one recommendation for use of at least one cosmetic product based on the information, Examiner points out that Maloney teaches providing customized beauty products, including shampoo or lotion (P. 7, L. 16, 24-26), which constitutes "generating recommendations" for use of said products.

In response to applicant's argument that Maloney and Fox fail to teach or suggest generating at least one recommendation for use of at least one cosmetic product based on local information obtained by manipulating received demographic data, it is noted that Fox was applied for this feature. Specifically, Fox teaches a computer-implemented method and system for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1),

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including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to providing personal care products or services to consumers based on demographic information. So as weather is a local phenomenon, determining and predicting local weather conditions based on determined location information can predict the impact of weather on sales of goods in said determined location (*Fox*; C. 4, L. 10-11, 58-61). As such, the motivation to combine references to include determining and predicting local weather conditions based on local information, as disclosed in *Fox*, would be utilizing local actual and forecasted weather information (e.g., temperature and humidity) in planning of sales and advertising of personal care products to maximize profits.

Claims 43-47 (Brief, pages 34-35)

In response to applicant's argument that Maloney and Fox fail to teach or suggest generating at least one cosmetic analysis based on at least one of the personal information and the local information, it is noted that Maloney explicitly teaches this feature. Specifically, Maloney teaches that the obtained consumer profiling data, including personal information and local (environmental) information is analyzed to determine customized beauty care products for the consumer (P. 9, L. 5-9; P. 11, L. 6-15, 20).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to providing personal care products or services to consumers based on demographic information. So as weather is a local phenomenon, determining and predicting local weather conditions based on determined location information can predict the impact of weather on sales of goods in said determined location (Fox; C. 4, L. 10-11, 58-61). As such, the motivation to combine references to include determining and predicting local weather conditions based on local information, as disclosed in Fox, would be utilizing local actual and forecasted weather information (e.g.,



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temperature and humidity) in planning of sales and advertising of personal care products to maximize profits.

Claims 49 and 50 (Brief; pages 35-36)

In response to applicant's argument that Maloney and Fox fail to teach or suggest "generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information, which is based on demographic information and historical information associated with the geographic area," it is noted that Maloney teaches providing customized beauty products, including shampoo or lotion (P. 7, L. 16, 24-26), which constitutes "generating recommendations" for use of said products. As per "local information is based on demographic information and historical information associated with the geographic area," it is noted that Fox was applied for this feature. Specifically, Fox a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), providing a historical weather information for various regions; accessing and determining local weather information based on said demographic (location) information and historical weather information for said geographical region (C. 13, L. 3-8).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to providing personal care products or services to consumers based on demographic information. So as weather is a local phenomenon, determining and predicting local weather conditions based on determined location information can predict the impact of weather on sales of goods in said determined location (*Fox*; C. 4, L. 10-11, 58-61). As such, the motivation to combine references to include determining and predicting local weather conditions based on local information, as disclosed in *Fox*, would be utilizing local actual and forecasted weather information (e.g., temperature and humidity) in planning of sales and advertising of personal care products to maximize profits.

*Argument E*  
*Claim 10 (Brief, pages 36-37)*

In response to applicant's argument that *Maloney* and *Fox* fail to teach or suggest "generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information

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that is based on demographic information,” Examiner points out that Maloney teaches: obtaining personal information about a consumer including a geographic area location of the subject (delivering a product to the customer indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (environmental data) *corresponding to* the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least the personal information and the local information (providing shampoo or lotion indicates “generating recommendations” for use of said products) (P. 7, L. 14-15; P. 7, L. 11-13, 16, 24-26).

Fox was applied to show determining local (weather) information based on demographic (geographical) information. Specifically, Fox teaches a computer-implemented method and system for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed

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invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, both references relate to providing personal care products or services to consumers based on demographic information. So as weather is a local phenomenon, determining and predicting local weather conditions based on determined location information can predict the impact of weather on sales of goods in said determined location (Fox; C. 4, L. 10-11, 58-61). As such, the motivation to combine references to include determining and predicting local weather conditions based on local information, as disclosed in Fox, would be utilizing local actual and forecasted weather information (e.g., temperature and humidity) in planning of sales and advertising of personal care products to maximize profits.

*Argument F*  
*Claims 14-16, 28, 29 and 33 (Brief; pages 37-38)*

In response to applicant's argument that Maloney and Fox fail to teach or suggest "generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information," it is noted that Maloney teaches: obtaining personal information about a consumer including a geographic area location of the subject (delivering a product to the customer indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18);

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determining local information (environmental data) *corresponding* to the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least the personal information and the local information (providing shampoo or lotion indicates "generating recommendations" for use of said products) (P. 7, L. 14-15; P. 7, L. 11-13, 16, 24-26).

Fox was applied to show determining local (weather) information based on demographic (geographical) information. Specifically, Fox teaches a computer-implemented method and system for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8).

In response to applicant's argument that there is no suggestion to combine Maloney and Fox, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to providing personal care products or services to consumers based on demographic information. So as

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weather is a local phenomenon, determining and predicting local weather conditions based on determined location information can predict the impact of weather on sales of goods in said determined location (Fox; C. 4, L. 10-11, 58-61). As such, the motivation to combine references to include determining and predicting local weather conditions based on local information, as disclosed in Fox, would be utilizing local actual and forecasted weather information (e.g., temperature and humidity) in planning of sales and advertising of personal care products to maximize profits.

*Argument F'*  
*Claim 19 (Brief: pages 38-41)*

In response to applicant's argument that "Official Notice is not supported by a documentary evidence and is provided without a clear and unmistakable technical line of reasoning supporting the Official Notice", it is noted that Official Notice was, in fact, supported by a documentary evidence. Specifically, Official Notice was taken that it was old and well known that a plurality of consumers had a habit to use cosmetic product every day. The documentary evidence used was Ogilvie et al.: Why Women Wear Lipstick: Preliminary Findings; page 4, 5<sup>th</sup> paragraph.

As per applicant's argument that there is no suggestion to combine Maloney and Fox and Official Notice, it is noted that if it is old and well known that consumers had a habit to use cosmetic product every day, it would have

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been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney in view of Fox to include *suggesting* that the consumer maintain a stock of the plurality of cosmetic products, because it would advantageously allow the consumer never run out of cosmetic products especially when the consumer needs them the most.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor N. Borissov

/Igor N. Borissov/  
Primary Examiner, Art Unit 3628

Conferees:

John H. Hayes, SPE 3628

/JOHN W HAYES/  
Supervisory Patent Examiner, Art Unit 3628

John Weiss, SPE 3629

/John G. Weiss/  
Supervisory Patent Examiner, Art Unit 3629

